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| 10/082,674      | 02/22/2002  | Narihiro Omoto       | 16869S-044300US     | 3124             |

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EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/082,674

Applicant(s)

OMOTO ET AL.

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution History***

The following is provided to clarify the record.

On 22 February 2002, applicant filed the instant application, which claims priority to Application 2001-045945, filed on 22 February 2001 in Japan.

On 8 March 2005, the Examiner rejected claims 1-8 as anticipated by Ginter et al. (US 5892900).

On 6 June 2005, applicant amended claim 4, cancelled claims 1-3, 5-8 and added claims 9-12.

On 6 September 2005, the Examiner rejected claims 4, 9-12 as anticipated by Ginter, above.

On 13 December, applicant requested continued examination and included an amendment to the claims.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 13 December 2005 has been entered.

***Response to Amendment***

On 15 December 2005, applicant amended claims 4, 9, 11 and 12.

Claims 4, 9-12 are pending and will be examined.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Amended claims 9, 11 and 12 refer to "...register[-ing] a terminal<sup>1</sup>..."

Claims 9 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 9, 11 and 12 are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no mention of registering a terminal in the disclosures. It is not clear how a ***terminal*** can be registered.

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<sup>1</sup> A terminal, in networking, is a device consisting of a video adapter, a monitor and a keyboard. MICROSOFT PRESS Computer Dictionary.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how a **terminal** can be registered. For examination, the limitation will be interpreted as registering a **user** or his **device**, as in Ginter Col. 20, lines 4-22.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 4, 9-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al. (US 5892900).

Ginter discloses system, methods and computer-readable storage media for monitoring the execution of software applications in a centralized electronic hub (applicant's electronic mall). Ginter's electronic hub includes storage for software that may be registered by a **plurality of content providers** (applicant's plurality of

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application systems providers/ASP). Ginter discloses charging users for usage of the various software according to various schemes, including applicant's methods of recording start and end time of utilization. Ginter discloses settling accounts, such as by paying content providers for use of their software.

As to applicant's latest amendment, directed to **a plurality of ASPs and their servers**, please note that Ginter's centralized electronic hub (applicant's electronic mall) includes various participants and their linking servers (hardware and software). Their actions take place **on** and **in** Ginter's system (applicant's electronic mall). Ginter shows a plurality of applicant's ASP's, each of which inherently needs a server to be part of the system.

***As per claim 9***, Ginter discloses an electronic mall system comprising a plurality of user terminals and a plurality of servers of ASPs coupled via a network comprising:

**an ASP registration database** (for example, see at least Col. 142, lines 42-64, Col. 168, lines 1-67), for storing information on

- The plurality of ASPs (Col. 335, line 53-Col. 336, line 19),
- a plurality of applications provided by the plurality of the servers of the ASPs (for example, content Objects, Col. 141, lines 4-33);
- linkable applications working with the applications associated with one another (for example, Col. 184, line 32-Col. 185, line 152;

**an application search unit** (for example, Col. 309, lines 38-55, see also references to general search characteristics), operative

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- to receive an application search request from any one of the user terminal via a network (at least Col. 38, line 36-Col. 39, line 3, Col. 58, lines 28-49), and
- to search the ASP registration database on the basis of the received application search request [thereby obtaining a requested application] and determine if the application requested from the user [terminal] is registered in the ASP registration database and if an application linkable to the requested application is registered in the ASP registration database (see at least Col. 22, line 26-Col. 23, line 33, Col. 38, line 36-Col. 39, line 3. See also Col. 20, lines 4-44.

**an application execution unit operative**

- to execute the requested application on the electronic mail system if the requested application is registered in the ASP registration database (See, for example, at least references to real time content and online interactive content passed to a client Col. 134, lines 39-58. See also at least references to objects that may be only available at remote sites, as in Col. 198, line 41-Col. 199, line 31. See also references to applications that are executed at a server and that transmit only results to a client, such as stock reports, Col. 308, lines 36-61) and
- to execute a linkable application on the electronic mail system if the linkable application is registered in the ASP registration database along with the requested application. See, for example, Col. 185, lines 15-53, which discloses registering a linkable application that is registered in the database, such as spreadsheet software program.

***As per claim 4,*** Ginter discloses the system of claim 9 further comprising:

means for executing an application in benchmark mode. The term benchmark is interpreted to read on guest ID, temporary ID, trial subscription. See, for example, at least references to trial subscription, Col. 215, lines 6-42.

benchmark means for preventing the utilization charge from being levied for an application executed for not longer than a predetermined time by the user desirous of checking the performance of said application. See, for example, at least Col. 140, lines 10-61.

***As per claim 10***, Ginter discloses the system of claim 9

- wherein the ASP registration database further includes utilization charge information for each application (See, for example, at least Col. 154, lines 21-Col. 155, line 35),
- wherein the electronic mall system further includes settlement means for settlement and distribution to content providers, please see at least Col. 316, lines 5-53)
  - for receiving the total amount of the application utilization charge from each application user, and for settling an application providing charge with each of the ASPs (See, for example, Fig. 4 and related text concerning different types of charges levied. For settlement and distribution to content providers, please see at least Col. 316, lines 5-53),

the total amount of the application utilization charge for each user calculated based

- on utilization charge information stored in the ASP registration database (See, for example, at least Col. 154, lines 21-Col. 155, line 35) and



- on information of a utilization start time and a utilization end time of the application as logged by the application execution unit when the application is executed (See, for example, at least Col. 154, lines 21-Col. 155, line 35), the application providing charge being calculated based on a measure of application utilization for each of the ASPs (See, for example, at least Col. 154, lines 21-Col. 155, line 35).

***As per claim 11***, Ginter discloses methods for executing applications on an electronic mall system which couples a plurality of user terminals and a plurality of servers of ASPs via a network (Ginter, Fig. 2 and related text), comprising:

**receiving** an application search request from any one of the user terminals via a network (to receive an application search request from a user terminal via a network (at least Col. 38, line 36-Col. 39, line 3, Col. 58, lines 28-49), and

**searching** an ASP registration database on the basis on the received application search request, the ASP registration database storing information on [a plurality of ASPs, a plurality of applications provided by the plurality of the servers of the ASPs, and linkable applications working with the applications associated with one another] (see at least Col. 22, line 26-Col. 23, line 33, Col. 38, line 36-Col. 39, line 3);

**determining** if the application requested from the user [terminal] is registered in the **ASP** registration database and if an application linkable to the requested application is registered in the **ASP** registration database. See at least Col. 20, lines 4-22.

**executing** a requested application on the electronic mall system if the requested application is registered in the ASP registration database (See, for example, at least

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references to real time content and online interactive content passed to a client Col.

134, lines 39-58. See also at least references to objects that may be only available at

remote sites, as in Col. 198, line 41-Col. 199, line 31. See also references to

applications that are executed at a server and that transmit only results to a client, such

as stock reports, Col. 308, lines 36-61); and

(d) executing a linkable application if the linkable application is registered in the ASP registration database along with the requested application (See, for example, Col. 185, lines 15-53, which discloses registering a linkable application that is registered in the database, such as spreadsheet software program).

***As per claim 12***, this claim is rejected on the same reasons set forth in Claim 11.

### ***Response to Arguments***

Applicant's arguments filed 15 December 2005 have been fully considered but they are not persuasive.

Previously (amendment of 5 June 2005), applicant argued that Ginter

...Accordingly, the present invention is different from Ginter in that the application **search function**, the application execution function, and linkable application registration & execution functions are not shown [in Ginter]....

Now, Applicant appears to argue that while the features are disclosed in Ginter, applicant does them differently:

Those [Ginter] repositories ***are not managed in a concentrated manner***..."...an application execution unit operative to execute the requested application **on** the electronic mail system...[etc.] ...The search scheme and search object of Ginter are different from the present invention ...

...In contrast, the present specification manages the contents by the ASP registration DB on the ASP electronic mail system in a concentrated manner. The search function 101 can extract the information by searching only one DB without using any agents. The

search scheme and search object of Ginter are different from the present invention. The present invention is characterized by having such ASP registration DB which manages the ASPs in a **concentrated** manner...page 6, lines 22-27, emphasis added.

First, the Examiner notes that Ginter manages repositories in a concentrated manner. See, for example, Fig. 1, which shows a **centralized** system to manage various repositories. The Examiner also notes that the features are not in applicant's claims.

As to applicant's latest amendment, directed to a **plurality of ASPs and their servers**, please note that Ginter's centralized electronic hub (applicant's electronic mall) includes various participants (e.g., content providers, applicant's ASPs) and their linking servers (hardware and software). Their actions take place **on** and **in** Ginter's system (applicant's electronic mall), as in Fig. 2.

Again, the Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
17 February 2006

*James Zurita*  
*Patent Examiner*